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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,232	02/05/2001	Lorraine Mignault	82223-202	1664

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CANADA

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/12/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/762,232

Applicant(s)

MIGNAULT, LORRAINE

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001 and 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-22, and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's amendment of 30 November 2001 is entered. Claims 1, 8, 9, 10, and 17 are amended. New claim 24 is added. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim is drawn to a method of inducing deeper sleep, while the previous claims are drawn to a composition, a process for preparing a composition, a method of treating pain, or a method of preventing hair loss. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-11, 17-22, and 24 are pending. **Any previous rejections that are not restated in this Office Action are hereby withdrawn.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments***

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, for lack of enablement for reasons as stated in a previous Office Action. The claims are drawn to a method of preventing hair loss.

Applicant argues that "the Examiner can only reject a claimed invention as useful for a particular invention if the Examiner feels that that use is not credible". Applicant's

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argument is considered moot in that it applies to rejections under 35 U.S.C. 101, while the current rejection is under 35 U.S.C. 112, first paragraph.

The applicant further requests reconsideration of the rejection in view of the declaration from Connie Rocha regarding the use of the invention for treating hair loss. The declaration of Ms. Rocha has been considered, but is not persuasive. The results disclosed by Ms. Rocha are on a male client who lost his hair due to German measles some 20 years ago. Therefore, the results are not relevant to a claim for a method of preventing hair loss. It is the position of the examiner that the standard for enablement of prevention of hair loss would involve at least a showing that hair loss would have occurred in the absence of prevention. The applicant does not provide a standard for accurately predicting hair loss nor is such a standard available in the art. As such, applicant cannot reasonably show the prevention of hair loss. Therefore, the rejection is maintained.

The following new grounds of rejection are made:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Weed (Wise Woman, Herbal Healing Wise; 1989, pp. 192-205). Weed discloses hot water

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extracts of oatstraw (see page 205). The extracts are in the form of oatstraw baths.

Weed states "Use an oatstraw footbath to soak away stink, sweat, cold, and pain from you tender tootsies," (page 205). For purposes of examination, water as disclosed by Weed is considered to be inherently equivalent to "filtered and magnetized water" as claimed in claim 2.

### ***Claim Rejections - 35 USC § 103***

Claims 1-9, 17-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weed (Wise Woman, Herbal Healing Wise; 1989, pp. 192-205) in view of Puchalski, Jr. et al (US Pat. 4,690,818) and Jakobson et al (US Pat. 5,397,497).

Weed teaches hot water extracts of oatstraw (see page 205). The extracts are in the form of oatstraw baths. Weed states "Use an oatstraw footbath to soak away stink, sweat, cold, and pain from you tender tootsies," (page 205). For purposes of examination, water as disclosed by Weed is considered to be equivalent to "filtered and magnetized water" as claimed in claim 2. Weed teaches the use of aqueous extracts of oatstraw applied externally to treat pain from any internal distress, including uterine pain. For purposes of examination, uterine pain is considered to meet the limitation of menstrual cramps. Weed also teaches the use of the extract for treating skin diseases, flaky or dry skin, wounds, and eye irritations. A bath composition meets the limitation of a body wash. The reference lacks addition of glycerin and lavender oil, as well as weight percentages of the same and a teaching of a process for preparing a composition by addition of the components.

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Puchalski teaches shampoo and bath and shower gels. Puchalski teaches that a polyol to enhance skin feel may be present in the compositions, including glycerin (see col. 3, lines 22-32).

Jakobson teaches bath additive compositions. Jakobson teaches the addition of oils such as lavender oil in order to impart a medicinal activity to the composition in that the oils exert a relieving or healing action on the human body and/or exhibit a therapeutic activity by means of a relaxing, refreshing, or vitalizing effect.

With respect to the weight percentages of the components, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). With respect to the claimed process for preparing the composition, the process involves combining the recited components. It is the position of the examiner that a process for preparing a composition which is merely the process of combining the components is rendered obvious by the composition itself.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Weed by the addition of glycerin in order to benefit from the enhanced skin feel imparted by glycerin as taught by Puchalski and by the addition of lavender oil in order to benefit from the relieving or healing action of lavender oil as taught by Jakobson.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis  
Examiner  
Art Unit 1617

February 8, 2002



**MICHAEL G. HARTLEY**  
**PRIMARY EXAMINER**